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William Nelson Davis

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BREINER & BREINER, L.L.C.  
P.O. BOX 320160  
ALEXANDRIA, VA 22320-0160

EXAMINER

FABER, DAVID

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RECORD OF ORAL HEARING  
UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM NELSON DAVIS  
and STEVEN JOHN KUHLMAN

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Appeal 2009-009743  
Application 10/621,275  
Technology Center 2100

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Oral Hearing Held: March 16, 2010

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Before LANCE LEONARD BARRY, JAY P. LUCAS, and  
CAROLYN D. THOMAS Administrative Patent Judges

ON BEHALF OF THE APPELLANTS:

Mary J. Breiner, Esq.  
Breiner & Breiner, LLC  
115 North Henry Street  
Alexandria, Virginia 22320-0160

1           The above-entitled matter came on for hearing on Tuesday, March 16,  
2   2010, commencing at 9:07 a.m., at the U.S. Patent and Trademark Office, 600  
3   Dulany Street, 9th Floor, Hearing Room A, Alexandria, Virginia, before Jon  
4   Hundley.

5           THE USHER: Good morning, Calendar Number 53: Appeal  
6   Number 2009-009743, Ms. Breiner.

7           MS. BREINER: Thank you.

8           JUDGE BARRY: Mr. court reporter, I'll say we're on the  
9   record, we're off the record, and give you the cue.

10           Ms. Breiner, you have 20 minutes, and we'll go ahead and use the  
11   timer, assuming that's working. We are on the record.

12           MS. BREINER: Good morning. May it please the Board, we  
13   are here today dealing with claims that are directed to a method and system  
14   for a distribution of fonts by rental. They specifically require accessing  
15   certain subscription information, and based on that providing for a  
16   predetermined time period as well as access. And this is tracked, so that upon  
17   the expiration the fonts that are provided are disabled.

18           All the rejections are under Section 103 and rely on two  
19   references, Ying and Hayes. Neither one of these provide for the rental. Ying  
20   is directed to the outright purchase of fonts. They teach the conventional  
21   purchase where you select it, stick it in the cart and you purchase it. The  
22   Examiner acknowledges this. He acknowledges that it doesn't teach tracking  
23   and disablement.

24           He also acknowledges that Hayes does not teach tracking and  
25   disablement. Hayes is relied on for the fact that while they teach a purchase,  
26   they also teach prior to purchase a preview period. The preview period,

1    however, while the Examiner equates it to our rental, is not the same. The  
2    Hayes specifically teaches during a preview that the fonts are not activated.  
3    So essentially it's what you think of in terms of a movie preview. It's a teaser,  
4    gets you to see it and want it, so you purchase it. This is not what our claims  
5    are directed to.

6                    And so based on that, we have fundamental limitations of the  
7    claim that are not taught by the references, either the primary, and with regard  
8    to the secondary, they're applied simply to dependent claims and go to the  
9    encryption step or the debiting account step. So they do not go to meet the  
10   deficiencies of the primary references.

11                   And on that basis, I would say that it doesn't meet Section 103.  
12   It is not taught, which the Examiner acknowledges. It's not suggested on the  
13   basis that the element that the Examiner is relying on for the suggestion is  
14   different from what we're teaching.

15                   JUDGE BARRY: That's short and sweet. Any questions?

16                   JUDGE LUCAS: Okay. Ms. Breiner, in Ying, column 30, line  
17   29, there is mention that there are a number of limitations on the right to use  
18   in the license for the fonts, and one of the limitations mentioned that the  
19   Examiner has pointed out is on line 29, where the limitation on the length of  
20   time for which the fonts can be used. Okay?

21                   The Examiner has said this limitation is right in the license in  
22   Ying, and he has added to that an enforcement mechanism. The enforcement  
23   mechanism, the Examiner has pointed out, comes from Hayes. Hayes allows  
24   people to sample their fonts. And then in column 8 of Hayes it mentions that  
25   a font for sale may be sent with time out information, thus allowing the user  
26   to sample a font for a period of time -- I'm sorry -- with time out information,

1 thus allowing the user to sample the font for a period of time, and when the  
2 time expires, disabling the font. The Examiner has taken this enforcement  
3 mechanism from Hayes for fonts and added to Ying.

4 Now, that seems contrary to what you just alleged. How do you  
5 explain this?

6 MS. BREINER: Well, the item saying the Examiner is reading  
7 into Hayes, Hayes specifically states at column 10, lines 39 and 40, that  
8 during the preview the font is not activated. If it is not activated, you cannot  
9 be using it, so you are not sampling it. You are literally seeing it. You can  
10 see the feel of it, the design of it, but you cannot use it. What a rental is is  
11 you have the right to possess it and use it based on a fixed payment, so based  
12 on our claims, the limitations required for the set-up of subscription  
13 information, they have a defined period of time and a defined access. And  
14 they can actually use it for this time period in order to get a desired job done.

15 That's the whole purpose of our system, is to allow a user to have  
16 access to a specific font that they do not have in their system. They can have  
17 it for a limited time period, for a limited cost, and they do not have to worry  
18 about storing this font. It's oftentimes a font may be used in order to access  
19 something was sent to you so that you can read it properly. This is the  
20 missing font problem where such as the Word programs will automatically  
21 replace one, but it's not the same symbol, so you'll lose the meaning.

22 So in this case a rental versus a preview, where you are not able  
23 to activate it or not able to use it, it doesn't matter that it's after a time period  
24 pulled off in order to entice you to buy it, because you haven't been able to  
25 use it.

1                   So in that sense it is not the same as a rental. So it does not have  
2 the suggestion and does not make up for the teaching in Ying that they are  
3 teaching, simply, an outright sale. They are allowing you to buy it. It's yours.  
4 That's not what a rental is.

5                   JUDGE LUCAS: I see your point. Thank you for explaining  
6 that point of view.

7                   JUDGE BARRY: Anything further?

8                   JUDGE LUCAS: No.

9                   JUDGE BARRY: Thank you for your time.

10                  MS. BREINER: Okay. Thank you for your time.

11                  JUDGE BARRY: And we're off the record.

12                  The hearing was concluded at 9:11 a.m.

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